IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Ryusuke Nishida et al.

Application No.: 10/551,556   Confirmation No.: 3696

Filed: October 3, 2005   Art Unit: 2625

For: EDITING APPARATUS   Examiner: L. E. Wills

REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

      This is a Reply Brief under 37 C.F.R. § 41.41 following the Examiner's Answer dated May 26, 2010. The Reply Brief is timely filed within two months of the Answer. The Argument in the Appeal Brief is incorporated herein, and additional arguments responsive to the issues raised in the Examiner's Answer are offered.

I.   STATUS OF CLAIMS

A.   Current Status of Claims

A complete listing of the claims with corresponding status is provided as follows:

Claims 1-2 and 4-6. (Rejected).

Claim 3. (Cancelled).

B.   Claims On Appeal

Appellant hereby appeals the final rejection of claims 1-2 and 4-6.

II.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal, with separate arguments as noted in the following sections, are as follows:

A. Whether the Examiner erred in rejecting claims 1, 2 and 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara et al (U.S. Patent Pub. No. 2003/0026592, hereinafter referred to as "Kawahara '592").

B. Whether the Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty et al (U.S. Patent Pub. No. 2002/0175917, hereinafter referred to as "Chakravarty '917").

III.   ARGUMENT

III. A1.   In the Final Office Action of August 28, 2009, The Examiner erred in rejecting claims 1 and 2 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Claim 2 is dependant on claim 1 and thus incorporate the features therein.

Claim 1 recites:

An editing apparatus comprising:

> ***an edit list recognition unit*** *for recognizing an edit list describing edit contents in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;*
>
> ***a video content creation unit*** *<u>for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;</u>*
>
> ***an editing processor*** *for performing an editing process on the video content created by the video content creation unit; and*
>
> ***an edit list creation unit*** *for creating a new edit list described in the general-purpose data description language based on the editing process executed by the editing processor.*

Specifically, Kawahara '592 ***<u>fails</u>*** to disclose, suggest or teach "*a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information.*"

The Office Action, however, alleges these features can be found in paragraphs [0091-0092] of Kawahara '592. This is wholly inaccurate.

Kawahara '592 relates to a content forming apparatus and method, an editing list making method, a content making apparatus and method, an editing apparatus and method and an editing information making apparatus and method, used for forming a content in a predetermined format from multiple video and/or audio materials. Specifically, Kawahara '592 discloses a means for providing an edit decision list making method of making an edit decision list permitted to form a

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content with low image deterioration and supporting multiple image data formats with the capability of switching processes from one to another. Kawahara '592 also discloses an edit decision list including identification information for identification of a material for use in editing, and a format declare statement for defining a format of at least a certain material.

Paragraphs [0091-0092] of Kawahara '592 state:

> [0091] The editing terminals 15, 16 and 17 form together the essential part of the EPL maker 10. They read out the highly compressed sub materials from an internal recording medium and decode them, and display, on a monitor, a video reconstructed from the decoded material data. More specifically, the operator control the sub-material server 14 via any one of the editing terminals to effect a desired operation (playback, rewind or fast forward, etc.) while visually checking a video displayed on the monitor, thus making an EPL. The EPL includes identification information for identifying editing materials, and a format declare statement for defining a format of at least a certain material. It should be noted that the format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. The EPL including such a format declare statement will be described in detail later.

> [0092] The EPL formed by each of the editing terminals 15, 16 and 17 is stored into an EPL storage unit 18. The EPL stored in this EPL storage unit 18 is read out by the edit controller 20 which will produce an edit control signal based on the EPL and supply it to the content maker 30.

Essentially, paragraphs [0091-0092] Kawahara '592 disclose a means for making an EPL. An operator controls the sub-material server via one of the editing terminals to effect a desired operation while visually checking a video displayed on the monitor, thus making an EPL. The EPL is then read out by the edit controller and supplied to the content maker.

In contrast, Appellant's invention can execute editing processes based on various kinds of editing process information described in a versatile edit list and a new edit list can be created according to the editing process, so that a more advanced editing process can be executed regardless of the type of editing apparatus, thus making it possible to realize an editing apparatus capable of executing a more advanced editing process which can be executed by all editing apparatuses, regardless of the type of editing apparatus.

Appellant's specification at p. 13, line 9 through p.14, line 24 more precisely describe the claimed features of a video content creation unit such that converts all the video data and the audio data into a prescribed edit format suitable for execution of the editing process:

> [0059] In a case where the video data VD10 to VD12 and the audio data AD10 and AD11 are created in different video formats and audio formats, the control unit 10 cannot perform an editing process in real time because of very heavy processing loads if it decodes data in the different formats and executes the editing process.

> [0060] Therefore, the control unit 10 converts all the video data VD10 to VD12 and the audio data AD10 and AD11 into a prescribed edit format suitable for execution of the editing process and then execute the editing process, resulting in performing the editing process in real time.

> [0061] Specifically, at step SP8, the control unit 10 converts the video data VD10, VD11 and VD12 into the edit format suitable for editing processes of the nonlinear editing apparatus 3A to create video data NVD10, NVD11 and NVD12 for nonlinear editing (FIG. 9), and extracts desired video parts of the video data NVD10, NVD11 and NVD12 for nonlinear editing based on the edit point information of the SMIL file SF10 and stores them in the hard disk drive 14 as video clips NVC10, NVC11, and NVC12 for nonlinear editing.

> [0062] In addition, the control unit 10 converts the audio data AD10 and AD11 into the edit format suitable for editing processes of the nonlinear editing apparatus 3A to create audio data NAD10 and NAD11 for nonlinear editing, and extracts desired audio parts of the audio data NAD10 and NAD11 for nonlinear editing based on the edit point information of the SMIL file SF10 and stores them in the hard disk drive 14 as audio clips NAC10 and NAC11 for nonlinear editing, and then moves on to step SP9.

> (Appellant's specification at p. 13, line 9 through p.14, line 24.)

Though, Kawahara '592 reads out the highly compressed sub materials from an internal recording medium and decode them, and display, on a monitor, a video reconstructed from the decoded material data, there is **_no mention_** of a video content creation unit that creates video content by executing an editing process **_after_** converting the plurality of edit material into a prescribed edit format suitable for the editing process **_and_** extracting desired video content of the plurality of edit material based on a plurality of edit point information.

The Final Office Action and the Advisory Action alleges that the format declare statement for defining a format of at least a certain material is equivalent to converting the plurality

of edit material into a prescribed edit format suitable for the editing process. However, it is noted that Kawahara '592 discloses that a format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. Clearly, the format declare statement does not <u>convert the plurality of edit material into a prescribed edit format.</u>

Nevertheless, the Examiner's Answer opines that Kawahara '592 discloses Appellant's claimed invention. The Examiner's Answer states that *"video content creation unit that creates video content by executing an editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process,"* is analogous to decoding of highly compressed sub materials which is considered a conversion process done before execution of the edit process. The Examiner's Answer also alleges that *"extracting desired video content of the plurality of edit material based on a plurality of edit point information,"* is analogous to decompression of the compressed sub-materials the format declare statement and identification information is extracted. This is inaccurate and incomplete reading of paragraph [0091].

While paragraph [0091] of Kawahara '592 discloses reading out highly compressed sub materials from an internal recording medium and decode them, and display, on a monitor, a video reconstructed from the decoded material data, there is *no mention* of a video content creation unit that creates video content by executing an editing process after *<u>converting the plurality of edit material</u>* into a prescribed edit format suitable for the editing process *<u>and extracting desired video content of the plurality of edit material</u>* based on a plurality of edit point information. Indeed, there is no discussion of converting a plurality of edits materials into a prescribed edit format, let alone extracting the desired video content from the that plurality of edit materials. Note that Appellant has already refuted Examiner's position paragraph [0091] of Kawahara '592 as described above.

The characterization within the Office Action and the Advisory Action of the claim language appears to recast the express language found within the claims by redefining the invention in a manner different that from what is set forth within the claims.

Because Kawahara '592 fails to disclose, teach or suggest various features of claim 1, a *prima facie* anticipation rejection has not been established, and reversal of this rejection is

respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). ("The identical invention must be shown in as complete detail as is contained in the … claim.").

For the foregoing reasons, Appellant respectfully requests reversal of the Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Reversal of the Examiner's decision is respectfully requested.

A2. The Examiner erred in rejecting claim 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Claim 6 recites:

An editing method comprising:

an edit list recognition step *of recognizing an edit list in which edit contents are described in a general-purpose data description language, the edit contents used for creating a series of video content by editing a plurality of edit material;*

a video content creation step *of creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation step creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information;*

an editing processing step *of performing the editing process on the video content created in the video content creation step; and*

>*an edit list creation step* of creating a new edit list described in the general-purpose
>data description language based on the editing process executed in the editing
>processing step.

As previously discussed, Kawahara '592 discloses a means for providing an edit decision list making method of making an edit.decision list permitted to form a content with low image deterioration and supporting multiple image data formats with the capability of switching processes from one to another. Kawahara '592 also discloses an edit decision list including identification information for identification of a material for use in editing, and a format declare statement for defining a format of at least a certain material.

There is **_no mention_** of a video content creation unit that creates video content by executing an editing process **_after_** converting the plurality of edit material into a prescribed edit format suitable for the editing process **_and_** extracting desired video content of the plurality of edit material based on a plurality of edit point information in Kawahara '592.

As discussed above in further detail in the preceding section, Kawahara '592 discloses how a format declare statement specifies, in detail, a time taken for capture of one frame, shutter speed for capturing, effective pixel number, etc. Clearly, the format declare statement does not convert the plurality of edit material into a prescribed edit format.

Again, the characterization within the Final Office Action, the Advisory Action and the Examiner's Answer of the claim language appears to recast the express language found within the claims by redefining the invention in a manner different that from what is set forth within the claims.

For the foregoing reasons, Appellant respectfully requests reversal of the Examiner's rejection of claim 6 under 35 U.S.C. § 102(b) as being as being anticipated by Kawahara '592.

Reversal of the Examiner's decision is respectfully requested.

B1. The Examiner erred in rejecting claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty '917.

Claims 4 and 5 depend from and thus incorporate the features of claim 1, which is neither disclosed nor suggested by Kawahara '592, for the reasons stated above.

Chakravarty '917 does not remedy the deficiencies of Kawahara '592, as the various features recited above are also absent from Chakravarty '917. For example, Appellant's claimed features of "*a video content creation unit for creating the video content by performing an editing process on the plurality of edit material based on the edit contents of the edit list wherein the video content creation unit creates the video content by executing the editing process after converting the plurality of edit material into a prescribed edit format suitable for the editing process and extracting desired video content of the plurality of edit material based on a plurality of edit point information,*" are neither disclosed nor suggested by Chakravarty '917.

Chakravarty '917 concerns computer-implemented or computer-enabled methods for creating, viewing, saving and editing, or storyboarding digital assets. Digital assets that may be storyboarded include, by way of example, digital video, digital audio, etc.

As discussed above, Appellant's invention can execute editing processes based on various kinds of editing process information described in a versatile edit list and a new edit list can be created according to the editing process, so that a more advanced editing process can be executed regardless of the type of editing apparatus, thus making it possible to realize an editing apparatus capable of executing a more advanced editing process which can be executed by all editing apparatuses, regardless of the type of editing apparatus.

There is ***no mention*** of a video content creation unit that creates video content by executing an editing process ***after*** converting the plurality of edit material into a prescribed edit format suitable for the editing process ***and*** extracting desired video content of the plurality of edit material based on a plurality of edit point information in Chakravarty '917.

Because Chakravarty '917 fails to disclose, teach or suggest various features of claim 1, a *prima facie* anticipation rejection has not been established, and reversal of this rejection is respectfully requested. *See, e.g., Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,

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631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference"). *See also Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1566 (Fed. Cir. 1989). ("The identical invention must be shown in as complete detail as is contained in the ... claim.").

For the foregoing reasons, Appellant respectfully requests reversal of the Examiner's rejection of claims 4 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Kawahara '592 in view of Chakravarty '917.

Reversal of the Examiner's decision is respectfully requested.

C1. Claims 7-8 are presumed to be allowable since there has been no 35 U.S.C. § 103(a) or 35 U.S.C. § 102(b) rejections to these claims.

Claims 7-8 have not been rejected in the Final Office Action dated October, 28, 2009. Moreover, the Panel Decision of February 1, 2010 has only called for rejected claims 1-2 and 4-6 to proceed to the Board of Patent Appeals and Interferences

However, in the PTO communication of June 6, 2010, the Examiner has introduced new grounds of rejections for claims 7-8 without giving the Appellant a chance to respond.

As such, Applicant believes claims 7-8 are allowable if re-written into independent form.

Dated: July 13, 2010

Respectfully submitted,

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